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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,195	06/13/2001	Kelvin Brian Dickinson	J3544(C)	6049

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,195

Applicant(s)

DICKINSON ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt of Request for Reconsideration received on June 13, 2005 is acknowledged. Claims 1, 7, 13-17 are pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 7, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0546235 by itself .

EP teaches a hair-restorer containing a mixture of castor oil, almond oil, olive oil, and coconut oil in equal proportions for application to the scalp. EP teaches that the criticality of the invention lies in the fact that at least three vegetable oils are utilized, with the preference to coconut oil, olive oil, castor oil, and almond oil. EP teaches the use of the vegetable oils lies in the fact that vegetable oils are fatty acid glycerol esters. See page 3. Glycerol **and/or** paraffin oil (liquid paraffin or Vaseline oil) may be added. Glycerol is taught as a humectant and paraffin oil

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is taught as a diluent for the active substances contained in the vegetable oils. See abstract and page 5. The hair-restorer stops hair loss, stimulates the growth of strong healthy hair and cares for protects the scalp. See page 3, lines 3-7.

The example teaches 1/6 parts of each castor oil, almond oil, olive oil, coconut oil, glycerol, and paraffin (liquid paraffin or Vaseline oil). See page 5, third paragraph. Thus, the composition contains 64% of vegetable oils.

EP's claim 1 is directed to a composition containing castor, almond, and olive oil in equal amounts. Claim 2 recites the additional use of coconut oil and claim 3 recites the additional use of glycerol **and/or** paraffin oil. Thus, the combination of the claims yield a composition that either contains 1) castor oil, almond oil, coconut oil, olive oil, and glycerol in equal proportions or 2) castor oil, almond oil, coconut oil, olive oil, and paraffin oil in equal proportions or 3) castor oil, almond oil, coconut oil, olive oil, paraffin oil, and glycerol in equal proportions.

Although EP suggests the use of paraffin oil or glycerol, the example utilizes both glycerol and paraffin oil, thus EP exemplifies 16% of paraffin oil and it does not exemplify the instant lower limit of 20% paraffin oil. Secondly, EP does not specify the liquid paraffin oil.

However, it is deemed obvious to one of ordinary skill in the art at the time the invention was made to look to the prior art conditions and remove glycerol in the composition to yield the instant composition with the instant range of all components. One would have been motivated do so since firstly EP suggests that the composition may contain glycerol **or** paraffin oil with the critical components of olive, castor, almond, and coconut oil. Therefore, a skilled artisan would expect similar results by removing glycerol from the composition as suggested by EP. Thus, if one removed glycerol from the composition, one would obtain the instant composition in instant

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amounts. For instance, EP teaches the preference of components in equal amounts. If glycerol is removed from the example in accordance to one suggested embodiment of EP, one would obtain a composition with 20% coconut oil, 20% olive oil, 20% castor oil, 20% almond oil, and 20% paraffin oil. It should be further noted that although olive oil and castor oil are not among the claimed Markush group, the examiner points out that the use of one vegetable oil versus another is deemed to be an obvious skill. Moreover, it is noted that applicant's disclosure allows for a wide variety of vegetable oils that including olive oil and castor oil, therefore it is the examiner's position the criticality of the invention does not lie in the type of vegetable oil used and rather a oil that has one or more glyceride fatty acid esters.

With regard to the specific viscosity of the liquid paraffin oil, it should be first noted that EP's liquid paraffin is another name for mineral oil (note page 422 of Grant & Hackh's Chemical Dictionary). Liquid paraffin has 10 to 18 carbons (note page 436 of Grant & Hackh's Chemical Dictionary) and light oils (hydrocarbons) are considered to have C12 to C20. Therefore, since EP teaches a liquid paraffin oil (carbon atoms of 10-18) and applicant claims a light mineral oil with 6-16 carbon atoms (straight chained) or 6-20 carbon atoms (branched), it is the examiner position that EP would have a similar viscosity. Note the art of interest: Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 436. Furthermore, since the prior art teaches a light mineral oil, it is the examiner's position that it would have a similar viscosity as the claimed invention. Moreover, it is the examiner's position that selecting the desired mineral oil with the desired viscosity is within the skill of the art since this selection process depends on the desired product, i.e. a viscous or non-viscous product.

Response to Arguments

Applicant argues that EP does not teach the required amount of the instant vegetable oils. Applicant argues that the example only contains 33.3% of almond oil and coconut oil. Further, applicant argues that if glycerol is eliminated in the EP's example, the example would only comprise 40% almond oil and coconut oil.

Again it is pointed out that the claims are rejected under obviousness and thus the prior art need not anticipate the instant invention. Firstly with regard to claim 1, the examiner points out that although olive oil and castor oil are not part of the Markush group claimed, it is obvious to one of ordinary skill in the art to utilize any vegetable oil since the criticality of the invention does not lie in the type of vegetable oil utilized. Moreover, the examiner notes that the instant disclosure states that any vegetable oil or animal oil may be used and the criticality of selecting the oil is that it contains glyceride fatty acid esters. Note pages 2-3. The examiner points out that EP's olive oil and castor oil comprise glyceride fatty acid esters. Applicant has not provided any evidence that the type of vegetable oil is critical.

With regard to claim 13, the examiner points out that component (i) only requires an oily components that has one or more glyceride fatty esters in the amount of 60-80% without distinguishing the type of oil component. Therefore, if one were to eliminate glycerol from EP's examples as suggested by EP, one would have a composition comprising 20% olive oil, 20% 20% castor oil, 20% coconut oil, and 20% almond oil, and 20% paraffin oil. Thus, the composition comprises 80% of oil components that contain glyceride fatty acid esters since all the vegetable oils (olive, castor, almond, and coconut) have one or more glyceride fatty esters.

Applicant argues that EP does not teach light mineral oil with the instant viscosity.

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Firstly, the examiner points to page 5 the instant specification wherein the applicant states that light mineral oil that has the instant viscosity has a carbon length of 10-28 and 12-20. The examiner again cites page 436 of Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 435-436, wherein liquid paraffin oil is defined as C10 to C18. Thus, EP would have a similar viscosity as instantly claimed since EP teaches liquid paraffin and liquid paraffin has 10-18 carbons, which falls within applicant's claimed carbon atom range.

Moreover for arguendo even if EP did not teach a light mineral oil, the examiner points out that this is an obvious parameter since one would have been motivated to utilize the mineral oil of choice depending on the desired viscosity. For instance, if one wanted to increase the viscosity, one would use heavy mineral oil. Conversely, if one wanted to have a low viscosity composition, one would utilize light mineral oil. Applicant has not provided the unexpectedness of the instant invention, i.e. comparing light versus heavy mineral oil.

Applicant argues that the light mineral oil provides a better feel and enhanced penetration of the hair fiber. Applicant's argues the light mineral oil is less greasy, however US Patent 4904471 states that light mineral oil is **conventionally** used in hair treatments but it is not absorbed easily into the hair or skin and tends to sit on the surface of the skin, leaving a greasy feel. Thus, without evidence comparing light versus heavy mineral oil, arguments and assertions of unexpectedness (that light mineral oil is less greasy) cannot overcome an obviousness rejection since the prior art is actually demonstrating that light mineral oil is greasy. The applicant points to page 8 of the instant specification but this does not compare light mineral oil versus heavy mineral oil.

Accordingly the rejection is maintained.

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Claims 1, 7, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0546235 in view of Pavlin (5,998,570) in further in view of Jones (5,116,607).

The teachings of EP have been set forth above. EP teaches a hair restorer composition containing castor oil, almond oil, olive oil, and coconut oil in equal proportions for application to the scalp. Glycerol and/or paraffin oil (liquid paraffin or Vaseline oil) may be added.

Assuming that EP's paraffin oil does not have the same viscosity or a similar viscosity, the examiner relies on Pavlin to cure this deficiency.

Pavlin teaches personal care products with a clear carrier. Pavlin teaches the state of the art where there is a preference for transparent formulations. See column 1, lines 53-55. Further, Pavlin teaches the use of mineral oil and the preference for light mineral oil since it is less viscous than heavy mineral oil, colorless and transparent. See column 15, lines 45-65.

Jones teaches a hair dressing for pliable, softer hair. Jones teaches the use of a combination of oils such as castor oil, coconut oil, etc with light petrolatum as the predominant oil. See column 1.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the teaching so Pavlin and utilize the instant light mineral oil. One would have been motivated to use light mineral oil versus heavy mineral oil since light mineral oil is less viscous, colorless, and transparent as taught by Pavlin. Thus, a skilled artisan would have been motivated to use light mineral oil not only if he/she desired a low viscosity composition, but also for its colorless property. Absent evidence showing the criticality of light versus heavy mineral oil, it is the examiner's position this is obvious.

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Further, one would have been motivated to look to Jones since Jones teaches the state of the art wherein it is known to use light mineral oil is hair dressing composition.

Response to Arguments

Applicant argues that Pavlin does not cure the deficiency of EP since Pavlin teaches gels. Further, applicant argues that Pavlin does not suggest the instant hair oil with 60-80% of a first oily component as claims.

Applicant's arguments filed 6/13/05 have been fully considered but they are not persuasive. The examiner points out that the rejection is made under obviousness and thus neither reference needs to anticipate the instant claims. Rather the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; **nor is it that the claimed invention must be expressly suggested in any one** or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In instant case, EP suggests the instant invention. Further, it is the examiner's position that EP liquid paraffin would have a similar viscosity as that of the instantly claimed viscosity. However, assuming EP does not have a similar viscosity as claimed, then the only teaching EP is lacking is the use of light mineral oil. Pavlin does not have to teach a hair oil with the instant first oily component since EP is not deficient in this teachings. Therefore, the examiner relies on Pavlin to provide a motivation for an artisan to utilize light mineral oil over heavy mineral oil. Pavlin clearly states that light mineral oil since it is less viscous, colorless, and transparent. Pavlin further teaches that consumers prefer transparent products. Thus, Pavlin teaches two reason to utilize light mineral oil: 1) that it is colorless and transparent and 2) it is

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less viscous. Therefore, one would have been motivated to use light mineral oil if one wanted a less viscous product or if one wanted an anesthetically pleasing product. Note that the motivation to utilize light mineral oil does not have to be that of the applicant's.

Applicant argues that applying Jones is using impermissible hindsight. The examiner points out that Jones is a optional reference that is merely relied upon to show the state of the art where it is known to use light mineral oil for hair compositions.

Accordingly the rejection is maintained.

Claims 1, 7, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 1035855 entire document optionally in view of Pavlin (5,998,570).

DE teaches hair oil containing 50% olive oil, 40% paraffin oil, 9% isopropylmyristate, 0.5% N-acetylcysteine isopropylester, and 0.5% N-salicylic methionine isopropylester. It should be noted the terminology hair oil, is an implicit disclosure of the instant methodology. It should be noted that olive oil inherently contains "one or more glyceride fatty acid esters".

DE does not teach the instant 60% of the first oily component or the viscosity of the paraffin oil.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to manipulate the parameters of the prior art and utilize 60% of the instant oil. One would have been motivated to do so as part of the routine experimentation process to find to the optimal working range. Generally differences in concentrations does not support patentability of subject matter encompassed by the prior art absent the criticality of the ranges. With regard to claim 1, it would have been obvious to use any vegetable oil in place of the prior art's olive oil.

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Moreover, it is considered obvious for a skilled artisan to utilize the mineral oil of choice depending on the desired viscosity. For instance, if one wanted to increase the viscosity, one would use heavy mineral oil. Conversely, if one wanted to have a low viscosity composition, one would utilize light mineral oil.

Pavlin teaches personal care products with a clear carrier. Pavlin teaches the state of the art where there is a preference for transparent formulations. See column 1, lines 53-55. Further, Pavlin teaches the use of mineral oil and the preference for light mineral oil since it is less viscous than heavy mineral oil, colorless and transparent. See column 15, lines 45-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the teaching so Pavlin and utilize the instant light mineral oil. One would have been motivated to use light mineral oil versus heavy mineral oil since light mineral oil is less viscous, colorless, and transparent as taught by Pavlin. Thus, a skilled artisan would have been motivated to use light mineral oil not only if he/she desired a low viscosity composition, but also for its colorless property.

Response to Arguments

Applicant argues that the instant rejection does not cure the deficiencies of Pavlin nor does it render the claims obvious.

Applicant's arguments filed 6/13/05 have been fully considered but they are not persuasive. The examiner points out that the instant rejection is DE in view of Pavlin and thus the deficiencies of Pavlin are not the basis of this rejection. The examiner relies on Pavlin to cure the deficiencies of DE. Thus as set forth above, it is the examiner's position one would have been motivated to utilize light mineral oil in DE's composition for the reasons taught by Pavlin.

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Art of Interest

Grant & Hackh's Chemical Dictionary, Fifth Edition, 1987, pages 422 and 435-436.

GB 824,353 to Irma Andersin is cited as art of interest since Andersin discloses the state of the art. Andersin states, "It is well known to add to hair oils, which are composed essentially of mineral and/or vegetable oil including petroleum oils, olive oil, almond oil, and castor oil."

Conclusion

All the claims remain rejected at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

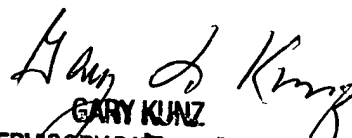
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
Examiner
Art Unit 1616

SSG


GARY KUNZ
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